Section II (REMARKS)

Response to the Statutory Double-Patenting Rejection of Claims 1-20

In the November 4, 2005 Office Action, the Examiner rejected claims 1-20 of the present application under 35 U.S.C. §101 for the "same invention" type double patenting, asserting that claims 1-20 of the present application "are identical words-by-words" to claims 1-20 of U.S. Patent No. 6,591,085 (see the Office Action, page 2, Section 2, lines 3-4).

Applicant respectfully disagrees, for the following reasons:

Claim 1 of U.S. Patent No. 6,591,085, from which the remaining claims 2-20 depend, recites:

> "1. An FM transmitter and power supply/charging assembly electrically coupleable with an MP3 player, said assembly comprising a modular docking unit having a main body portion with a docking cavity therein, wherein the main body portion contains said FM transmitter and power/charging circuitry, with coupling means in the docking cavity for connecting the MP3 player with the FM transmitter and power/charging circuitry, to accommodate FM transmission by said FM transmitter of audio content when played by said MP3 player in the docking cavity of the modular docking unit, and with means for transmitting electrical power through said modular docking unit and said power/charging circuitry therein, for charging of a battery of the MP3 player and/or powering of the MP3 player."

In contrast, claim 1 of the present application, from which claims 2-20 depend, recites:

> 1. (Currently amended) An FM transmitter and power supply/charging assembly electrically coupleable with an MP3 player, said assembly comprising a modular docking unit having a main body portion with a docking cavity therein, **with retention element for retaining the MP3 player in position in the cavity**, wherein the main body portion contains said FM transmitter and power/charging circuitry, with coupling means in the docking cavity for connecting the MP3 player with the FM transmitter and power/charging circuitry, to accommodate FM transmission by said FM transmitter of audio content when played by said MP3 player in the docking cavity of the modular docking unit, and with means for transmitting electrical power through said modular docking unit and said power/charging circuitry therein, for charging of a battery of the MP3 player and/or powering of the MP3 player.

Clearly, claims 1-20 of the present application require an additional element, i.e., the retention element, which is not recited by claims 1-20 of U.S. Patent No. 6,591,085.

Therefore, **claims 1-20 of the present application are NOT IDENTICAL to claims 1-20 of such U.S. patent, despite the Examiner's assertion**.

Further, it has been well established that a reliable test for double patenting under 35 U.S.C. 101 is whether there is an embodiment of the invention that falls within the scope of one claim, but not the other. *In re Vogel*, 164 USPQ 619 (CCPA 1970).

Applying such test to this case, a hypothetical product that contains every limitation recited by claim 1 of U.S. Patent No. 6,591,085 but lacking a retention element required by claim 1 of the present application, will literally fall within the scope of claim 1 of U.S. Patent No. 6,591,085, but not within the scope of claim 1 of the present application.

Therefore, claims 1-20 of the present application are not identical to claims 1-20 of U.S. Patent No. 6,591,085 under 35 U.S.C. 101.

Further, **claims 1-20 of the present application cannot be rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-20 of U.S. Patent No. 6,591,085**.

Claims 1-20 of U.S. Patent No. 6,591,085 do not in any manner provide any basis for a retention element for retaining the MP3 player in position in the cavity, which is expressly required by claims 1-20 of the present application.

The MPEP has clearly provided that when considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of patent, **the disclosure of the patent may not be used as prior art**. See MPEP §804(B)(1).

Further, **mere denials and conclusory statements regarding basic knowledge or common sense are not sufficient to establish a genuine issue of material fact** in support of the findings of obviousness. See *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001); *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999), citing *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Therefore, unless the Examiner provides some concrete evidence otherwise, besides mere disclosure of U.S. Patent No. 6,591,085 or merely conclusory statements by the Examiner, **claims 1-20 of the present invention are NOT obvious over claims 1-20 of U.S. Patent No. 6,591,085, by requiring a retention element for retaining the MP3 player in position in the cavity**, and the judicially-created doctrine of obviousness-type double patenting cannot be used as a basis for rejecting claims 1-20 of the present application.

Response to the Obviousness-Type Double-Patenting Rejection of Claims 21-40

In the November 4, 2005 Office Action, the Examiner rejected claims 21-40 of the present application under the judicially created doctrine of obviousness-type double patenting, asserting that claims 21-40 are obvious over claims 1-20 of U.S. Patent No. 6,591,085.

In response, Applicant has hereby amended claims 21, 21-23, 31, and 36-40, by **adding the new limitation of a retention element for retaining the MP2 player in position**.

Applicant hereby traverses the Examiner's obviousness-type double patenting rejections of claims 21-40, for the same reasons stated hereinabove for claims 1-20 of the present application.

Specifically, claims 21-40 requires various structural and/or functional elements, e.g., retention element, side rails, lateral tabs, retractable shelf, etc., for which claims 1-20 of U.S. Patent No. 6,591,085 provides completely no basis at all.

The Examiner did NOT cite a single prior art reference, but instead relied on mere conclusory statements or description by either U.S. Patent No. 6,591,085 or by the present application.

As mentioned hereinabove, when considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of patent, **the disclosure of the patent may not be used as prior art**. See MPEP §804(B)(1). Secondly, it is well established that **obviousness cannot be read into the invention on the basis of applicant's own statements**. *In re Nomiya*, 184 USPQ 607 (CCPA 1975), citing *In re Murray and Peterson*, 122 USPQ 364 (CCPA 1959), and *In re Sporck*, 133 USPQ 360 (CCPA 1962). Further, **mere conclusory statements regarding basic knowledge or common sense are not sufficient to establish a genuine issue of material fact** in

support of the findings of obviousness. See *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001); *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999), citing *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Neither the description by U.S. Patent No. 6,591,085 or the present application nor merely conclusory statements by the Examiner can be used to establish a *prima facie* case of obviousness against claims 21-40 of the present application.

Therefore, the obviousness-type double patenting rejections of claims 21-40 over claims 1-20 of U.S. Patent No. 6,591,085 are improper.

Based on the foregoing, Applicant respectfully requests the Examiner to reconsider, and upon reconsideration, to withdraw the double patenting rejections of claims 1-40 of the present application.

CONCLUSION

Based on the foregoing, claims 1-40 as amended herein are in form and condition for allowance.

The Office is hereby authorized to charge any official fee necessary for the entry of this Response to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

If any issues remain outstanding, the Examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss their resolution, so that this application may be passed to issue at an early date.

Respectfully submitted,

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